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In re Application of:

Alesi, Daniel E. et al

Serial No.: 09/920,860

Filed: Aug. 3, 2001

Docket: 0100/0129

Title: NEEDLE SAFETY DEVICE WITH
TORTUOUS PATH

DECISION ON PETITION

This is a decision on the petition filed on May 5, 2008 seeking to forward the case to the Board of Patent Appeals and Interferences for adjudication. This petition is being considered pursuant to 37 CFR § 1.181(a) (3). No fee is required for this petition. The petition fee paid may be refunded upon request.

The petition is **Granted**.

In the petition, the petitioner requests that the Director to direct the examiner to consider the appeal brief filed on May 5, 2005 and forward the application to the Board of Patent Appeals and Interferences for final resolution.

The record shows that:

- 1) In response to the applicant's amendment of Feb. 12, 2003, on May 6, 2003 the examiner mailed a final Office action.
- 2) On Jul. 25, 2003, the petitioner filed a notice of appeal followed with an appeal brief on Sep. 22, 2003, appealing the claims under final rejection.
- 3) On Mar. 16, 2004, the examiner issued a non-final Office action maintaining the rejection, but reopening the prosecution of the case.
- 4) On Jun. 15, 2004, the petitioner filed a new notice of appeal and a second appeal brief.
- 5) On Jul. 6, 2007, the examiner issued another non-final Office action maintaining the rejection, but reopening the prosecution of the case.
- 6) On Oct. 1, 2007, the petitioner filed third notice of appeal and third appeal brief.
- 7) On Feb. 5, 2008, the examiner issued another non-final Office action maintaining the rejection, but reopening the prosecution of the case.

- 8) On May 5, 2008, the petitioner filed fourth notice of appeal and fourth appeal brief.
- 9) On May 5, 2008 the present petition was filed requesting the examiner to forward the case to the Board of Patent Appeals and Interferences for its adjudication.

Discussion and Analysis

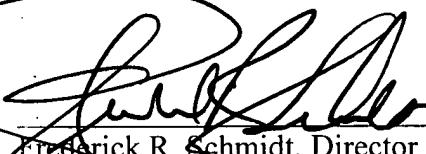
A review of the application reveals that there is a prolonged prosecution in this case. The application history also shows the examiner reopened prosecution three times. Office policy requires examiners to complete a thorough prior art search, and avoid piecemeal examination as much as possible. Office policy discourages piece meal prosecution as set forth in M.P.E.P. §707.07(g)¹. Regrettably due to late discovery of prior art, prosecution of the applicant's invention has been unavoidably prolonged. It should be noted that the Primary Examiner has a duty to consider the merits of the claims under M.P.E.P. § 1004. In order to avoid re-opening prosecution, the examiner is reminded to perform a complete and thorough search of prior art considering not only the claims presented, but also any subject matter the examiner reasonably anticipates might be incorporated into a subsequent amendment in accordance with M.P.E.P. 904.03².

In response to the petition, the examiner is hereby instructed to timely set up an appeal conference in accordance with M.P.E.P. §1207.01. Additionally, the examiner is also directed to conclude the examination of the application as soon as possible.

Conclusion

Under the circumstances, the relief requested by the petitioner is granted. The application is being forwarded to the Supervisory Patent Examiner in Art Unit 3767 for consideration of the appeal brief filed on May 5, 2008. Any inquiry regarding this decision should be directed to Henry Yuen, Special Programs Examiner, at (571) 272-4856.

Petition Granted.



Frederick R. Schmidt, Director
Technology Center 3700

¹ M.P.E.P. § 707.07(g) states: Piecemeal examination should be avoided as much as possible. The examiner ordinarily should reject each claim on all valid grounds available, avoiding, how-ever, undue multiplication of references

² M.P.E.P. § 904.03 states in relevant part: "It is normally not enough that references be selected to meet only the terms of the claims alone, especially if only broad claims are presented; but the search should, insofar as possible, also cover all subject matter which the examiner reasonably anticipates might be incorporated into applicant's amendment."